

REMARKS

Claims 9-11 and 13-16 are pending in the application. Claims 1-8, 12 and 17-22 have been canceled without prejudice or disclaimer. Applicants reserve the right to file one or more continuing applications directed to the subject matter recited in the canceled claims, as well as any other subject matter not covered by pending claims 9-11 and 13-16. Applicants respectfully request reconsideration of the application in view of the following remarks.

In the Office Action, claim 14 was objected to as being dependent upon a rejected base claim that would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants have rewritten claim 14 in independent form, including the limitations of its base claim 8 and intervening claim 12. Claims 9-11 and 13 have been amended to now be dependent on independent claim 14. Applicants respectfully submit that claims 9-11 and 13-16 are in immediate condition for allowance.

Claims 9-11 and 13-16 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. According to the Office Action, the claims recite a method which does not

[P]rovide useful, tangible and concrete results. The frame based knowledge tree is constructed without practical application as to how/what is the knowledge tree being used. Moreover, for it to be a tangible result, it must be more than just a thought or a computation. Instead, it must have real world value rather than being an abstract result.

Office Action at 4-5.

Applicants respectfully traverse this rejection and request reconsideration because nothing in the claims or the specification has been relied upon in the Office

Action to show (or even suggest) that the claimed method does not provide a useful, tangible and concrete result.

It is axiomatic that application claims must be construed in light of the application specification. As is evident from the specification, for example, at [0018] (application specification page 4), the “knowledge tree” constructed in accordance with the claimed method can be used to provide expert knowledge regarding a disparate number of products and product attributes. The knowledge tree can be configured as “product knowledge files for use, for example, with a product configuration system.” Id. An exemplary product configuration system is the system described in U.S. Patent No. 6,810,401. The knowledge tree generated in the claims, for example, can provide configuration files attaining product catalog data (e.g., product specifications) for a number of different products in different categories with each product having different attributes (e.g., diameter, length, material, finish, etc.) Id. at [0020]. The product configuration system can then utilize the knowledge retained within the knowledge tree to configure products as desired by its users, as described in more detail in U.S. Patent No. 6,810,401.

As can be seen, there can be no real issue (and the Office Action cites no evidence to the contrary) that the claimed method provides “real-world results” (e.g., configuration files) that are useful, tangible and concrete (e.g., as used by configuration systems such as those described in U.S. Patent No. 6,810,401). For at least these reasons, Applicants respectfully traverse this rejection and request reconsideration.

Claims 9-11 and 13-16 have been rejected under 35 U.S.C. § 112 (first paragraph). The only claim term pertinent to the remaining pending claims is the use of the term “act” in claim 14. The term “act” as used in method claim 14 generically refers to one of the claimed “accessing,” “receiving,” “automatically constructing,” and

"determining" actions, depending on the context. The term is used in its plain and ordinary sense (e.g., "anything done, being done, or to be done") and is intended to make clear that the claimed method is not in a "step-plus-function" format (under 35 U.S.C. § 112 (sixth paragraph)). As the term "act" is not the invention itself, but rather the term used in describing the invention, Applicants respectfully submit that the "written description" requirement under 35 U.S.C. § 112 (first paragraph) has not been violated. Applicants respectfully request reconsideration of the rejection and request that the rejection be withdrawn at least for the reasons given above.

As no other rejections pertain to claims 9-11 and 13-16, Applicants respectfully submit that the claims are in immediate condition for allowance. Applicants respectfully request that the application be reconsidered and passed to issue with claims 9-11 and 13-16 at the earliest possible convenience.

Applicants hereby petition for any extension of time which may be necessary to have this amendment considered. Applicants hereby authorize the Director to debit Account No. 04-1073 (under Order No. E0710.0004/P004) for any fees deemed necessary for that purpose.

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Respectfully submitted,

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